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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,413	10/17/2003	Mitsuhiko Miyazaki	62649.2	2210

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EXAMINER

TRINH, MINH N

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/688,413

Applicant(s)

MIYAZAKI, MITSUHIKO

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 15-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 30-35 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/21/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 11-17 and 30-35 in the reply filed on 8/15/06 is acknowledged. Thus, claims 1-10 and 15-29 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/15/06.

An Office action on the merit of claims 11-14 and 30-35 as follows:

### ***Claim Objections***

"A hand held"(claims 12-14, and 30-35 line 1) should be changed to: --The handheld--, so as to reflect the dependent claim formats.

"about 10° and about 14 °" (claim 34, line 2) should be: -- 10° to 14°--.

"about 12°" (claim 35, line 2) should be: -- 12°--

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Woolley Jr. (5,033,785). Woolley Jr discloses a handheld electric part handling device comprising:

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a pair of first and second legs 68, 72 respectively provided, at their free ends, with contact pieces 70, 74 for holding the part 16 or 10 therebetween; at least the first leg 72 being movable toward and away from the second leg to close and open the legs; a biasing member as spring 64 for biasing the first leg in a first direction to open the legs, and in a second direction to close the legs; and a switching member 60 for switching the biasing direction of the biasing member between the first and second directions (see Fig. 3-4).

4. Claim 11 is also rejected under 35 U.S.C. 102(b) as being anticipated by Femling (5,938,258). Femling discloses a handheld electric part handling device comprising: a pair of first and second legs 12, 14 respectively provided, at their free ends, with contact pieces 18, 20 for holding the part therebetween; at least the first leg 12 being movable toward and away from the second leg to close and open the legs; a biasing member as spring 82 for biasing the first leg in a first direction to open the legs, and in a second direction to close the legs; and a switching member 36 for switching the biasing direction of the biasing member between the first and second directions (see Fig. and the discussed at col. 4, lines 56-67).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolley Jr or Femling in view of Vandermark (3,804,320) or Conti (4,553,021).

Woolley Jr or Femling as relied upon above does not teach the limitations of claims 30-33, including the heat generating of the first and second legs, etc. however, each of the Vandermark or Conti teaches that (i.e., see abstract of each references for the teaching of heat generating on the legs of the device for purpose of soldering and/or desoldering). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the Vandermark or Conti's teachings as described in detail above onto the invention of Woolley Jr or Femling in order to form a desired structure having the supply heating current to the picking tip or legs of the device for various known benefits including soldering and or desoldering purpose, etc.

Limitations of claims 31-33 are also satisfied as the above discussion.

7. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolley Jr or Femling in view of Vandermark (3,804,320) or Conti (4,553,021).

Regarding limitations of claims 34-35, it would have been an obvious matter of design choice to choose any desired first and second angle configurations since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the configuration of the first and second angular configurations as shown in the prior art reference (i.e., see Fig. 5 of the Femling or Fig. 1 of the Vandermark, etc).

#### ***Allowable Subject Matter***

8. Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mt  
10/13/06

  
MINH TRINH  
PRIMARY EXAMINER